

3724
EPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

John VONEIFF, *et al.*

Examiner: Jason D. PRONE

Appln. No.: 10/091,173

Group Art Unit: 3724

Filed: March 6, 2003

Confirmation No. 1310

For: APPARATUS AND METHOD
FOR AUTOMATICALLY
PRODUCING TISSUE SLIDES

RESPONSE TO RESTRICTION REQUIREMENT

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **Mail Stop Amendment**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

The outstanding Office Action mailed on February 3, 2005, requires that Applicants elect one of the following two (2) allegedly distinct inventions:

INVENTION

CLAIMS

I

11-19 and 27-35

II

20-26

Applicants hereby elect **claims 11-19 and 27-35 (Invention I)** with traverse and respectfully request reconsideration of the restriction requirement in view of the following remarks.

Restriction is appropriate only when the groups of claims can be shown to be distinct and there would be a serious burden on the Examiner to examine more than one group of claims. MPEP § 803 (Emphasis added.). Applicants submit that there is no serious burden placed on the Examiner to examine Inventions I and II together. Accordingly, the restriction requirement is believed to be inappropriate.

CONCLUSION

Applicants maintain that the restriction requirement is improper and that all pending claims, *i.e.*, claims 11-35, should be examined for patentability. If the Examiner believes that the prosecution might be advanced by discussing the application with Applicants' representatives, in person or over the telephone, we would welcome the opportunity to do so.

Applicants believe that no fee is required for the submission of this Response. However, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Response or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

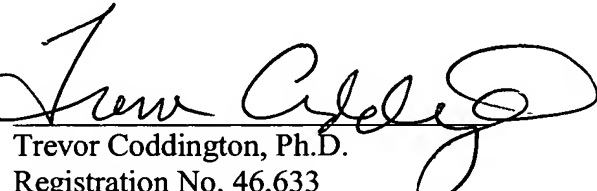
Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: February 22, 2005

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